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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,141	04/09/2001	John W. Chrisman III	4826US	8520

7590

04/07/2004

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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 04/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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ANSWER TO THE REMAND

On 1/16/04, the Board remanded Appeal with the underlying conclusion that this case as "not ripe for appeal" (pg. 2, ln. 50, remand) and what appears to be smaller issues of consideration to the Board such as, "the examiner's answer containing what they describe as another infirmity" (pg. 3, ln. 11, remand) and to "reconsider the pending prior art rejections" (pg. 4, ln. 3, remand). At the bottom of pg. 4, the Board takes the position that "these infirmities must be corrected in the form of reopened prosecution by the examiner". According to MPEP 1211 the Board has authority to remand a case to the examiner when it deems it necessary to set forth; 1) a fuller description of the claimed invention. 2) a further explanation of the pertinence of the references. 3) a further selection of the preferred or best grounds of rejection or 4) where it feels that the most pertinent art has not been cited, or to consider an amendment, affidavit, or declaration. (See MPEP § 1211.01, § 1211.02, and § 1211.03.) Further 37 CFR 1.196 states that;

- (a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner or remand the application to the examiner for further consideration. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.
- (b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim...
- (c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds of rejection...
- (e) Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

While MPEP 1211 and 37 CFR 1.196 does not specifically set forth that the Board may remand a case to demand the reopening of prosecution, the examiner has fully considered all of the Boards comments and concerns and addresses them in the following Answer to the Remand.

Initially in its Remand, the Board appears to be unclear from the prosecution and Answer as to what (pg. 2, ln. 7, Remand) is considered "old and well known" and the pertinence of the references provided to support the grounds of rejection taken by the examiner. As such, the Board's remand is being considered a remand 1) for a further explanation of the pertinence of the references in line with MPEP 1211 and 2) a remand to the examiner for further consideration in accordance with 37 CFR 1.196.

First to clarify the "two rejections" that the Board restates on pg. 1, ln. 4 of the remand and deems it as not having adequately identified the subject matter which "what is old and well known in bowling balls". On pg. 2, ln. 19

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the Answer explicitly states, "bowling balls of nonporous polymeric thermosetting resin is old and well known." This is admitted old at the bottom of pg. 2 of Appellant's specification". Claim 1 calls for a bowling ball having a "two-part resin" that is "non-porous" (claim 2), "rigid" (claim 3) and "two-part" polyurethane in claim 5. In light of these limitations in the claims the grounds of rejection in the Answer refers to the bottom of pg. 2 of appellant's specification calls for a polyurethane having "A-side" and "B-side" materials used to produce the polyurethane. What is old and well known to the prior art is bowling balls made of polyurethane with two-parts, an A-side" and "B-side". This addmition by appellant in his specification alone and by itself meets the limitations of claims 1-3 and 5. The grounds for rejection is explicit in the following line of the Answer where it states, "Lacking in bowling balls is the use of a fragrance." The grounds for rejection fills the gap by stating, "perfumed polymers intended for the purpose of making plastic articles with a fragrance are also well known," and applies the reference to Shibantai to teach such compounds to include synthetic resin products in order to enhance their smell. The simple question of obviousness facing the Board is whether or not it would have been obvious to have taken known fragranced polymers and used them to make a bowling ball. Since the specification and prosecution show that in doing such appellant has only produced a better smelling bowling ball, which is the intended purpose of such polyers (i.e. to improve the smell of the products made by them), and no other improvements to the game of bowling has been shown by appellant, such as higher scores or better rolling consistency, the claims stand rejected under 35 USC 103 as being obvious and should be affirmed.

The Board goes on to state that "the appellant seems to admit that it was known in the prior art to make bowling balls from polyurethanes which are then described in a fashion consistent with the 'two-part-resin'". The "two-part" resin limitation was added by appellant in his amendment paper No. 9 in appellants attempts to evade the art. In response to this, examiner made the assertion that, "using two-part resins to produce products are old and well known" (paper No. 10, pg. 3, ln 5). In response to this Office Action, Appellant filed and amendment under 37 CFR 1.116, paper No. 12. However, nowhere in this responset did appellant seasonable challenge the assertion that two-part resins were old and well known to produce products. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. Upon non-entry of the after final amendment, Appellant immediately appealed to the Board to resolve this issue. Not until appellant's Brief does he provide arguments specific to the limitation of a "two-part" resin. While he does not directly state that such is not old and well known, it can be inferred from his remarks arguing in favor of this limitation that is the case. Since MPEP 1208 requires that the examiner provide in his Answer, "a statement of whether the examiner disagrees with each of

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the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention," the examiner needed to clarify to the Board his position and the general level of ordinary skill in the art. Hence, since the examiner was merely clarifying his position and providing information to the Board regarding the level of ordinary skill, reopening prosecution would only serve to cloud and prolong the prosecution and the Board is asked to consider and affirm the instant grounds of rejection before them.

In addition, the Board appropriately noted that the Coffey patent was clearly omitted from the statement of the grounds for rejection in error. As admitted to by Board this reference is applied in the grounds for rejection in the final office action and listed as an applied reference in the Examiner's answer. Further the body of the grounds for the rejection explicitly discusses Coffey and how his teaching go to fill the gaps of the prior art in contrast to the claimed invention. Hence, it is made of record that the Coffey reference was omitted as an inadvertent oversight and the grounds for rejection should read as set forth in the final office action.

With respect to the what the Board considers "numerous references" discussed by the examiner in the Answer, as set forth above it was incumbent upon the examiner to provide to the Board a statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention in his Answer. Further it would not be appropriate for the examiner to take notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979). Likewise, it is never appropriate to rely solely on "common knowledge" or practices in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. In his Brief, Appellant presents to the Board detailed, never presented before in prosecution, arguments pertaining to two-part resins, fragrances, polyols, polymerization catalysts and discussions pertaining to polymer manufacturing techniques. The references were necessary to present to the Board the examiner's position with respect to Appellant's remarks in the Brief and to help the Board develop and understand only a portion of what is known in the art bowling, polymers and their manufacture. These references show the general skill of one practicing in the art of gaming and the motivation that would provide such persons. See *In re Berg*, 65 USPQ2d 2003 (Fed. Cir. 2003). Lastly, since these references were added only as directly corresponding evidence to support prior common knowledge finding, it does not result in a new issue or constitute a new ground of rejection which would warrant reopening prosecution.

While the Board cites *In re Hoch*, it is submitted that this is not on point since, as set forth above, these

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references were included only for the purposes of rebutting arguments set forth in the Brief and so that the Board could more easily ascertain the general level of skill of one practicing in the art.

In considering the Edwards patent, the appealed claims call for a "bowling ball" and "a method for manufacturing a bowling ball". Since any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990). Considering the fact that Edwards is directed to a "chewable toy" would not make it a better reference for rejection any of the appealed claims alone since the claims call for a bowling ball which would not be considered "chewable" or a "toy" by one skilled in the art. Clearly, the reference does have value in showing the general level of skill of one practicing in the art of adding "aromatic" (col. 2, ln. 15) additives to polyers, the use of two-part polyurethanes (lns. 50-57) and manufacture using such polymers (col. 6 and 7). However, any application of Edwards in a grounds for rejection would be considered to be merely an alternative to the one that is already before the Board and would serve no other purpose than to prolong and cloud the issues. Hence, the Board is asked to consider and affirm the grounds of rejection before them.

In conclusion, what the Board has considered as "infirmities" are merely examiner's rebutting arguments set forth in the Brief by showing the general level of skill of one practicing in the art. Appellant wishes the Board to believe that a non-obvious invention is before them. However, as shown by the discussion in the Answer of the references therein, he has done nothing more than applying known technology in the field of plastic products to that of a Bowling ball. With bowling balls being known to be made of polyurethane, a known polymer, the Board should affirm the examiners determination that applying known fragranced polymers to known polyurethane bowling balls would have been obvious in order to enhance their smell.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

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For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



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